APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/506,107	02/17/00	KIKINIS	P1534D1

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CENTRAL COAST PATENT AGENCY
PO BOX 187
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EXAMINER
COULTER, K

ART UNIT	PAPER NUMBER
2154	

DATE MAILED:
03/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

n Summary

Application No. 09/506,107	Applicant(s) Dan Kikinis	
Examiner Kenneth R. Coulter	Group Art Unit 2154	

.unication(s) filed on _Jan 2, 2001_

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.tion is in condition for allowance except for formal matters, **prosecution as to the merits is closed** vith the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

ied statutory period for response to this action is set to expire ____3____ month(s), or thirty days, whichever is from the mailing date of this communication. Failure to respond within the period for response will cause the .tion to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of ·R 1.136(a).

ʝisposition of Claim

☒ Claim(s) _17-33_ _____ is/are pending in the applicat

☐ Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) _17-33_ _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

   ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

   ☐ received.

   ☐ received in Application No. (Series Code/Serial Number) _____ .

   ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   *Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Double Patenting

1.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper tames extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.d. 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

2.   Claims 17 - 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 27 of U.S. Patent No. 6,076,109.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim language of the present Application and claims 1 - 27 in U.S. Pat. No. 6,076,109 contain the same information.

3.   Claims 17 - 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 17 of U.S. Patent No. 5,727,159.

Although the conflicting claims are not identical, they are not patentably distinct from each other

because the claim language of the present Application and claims 1 - 17 in U.S. Pat.

No. 5,727,159 contain the same information.

⁻ *Claim Rejections - 35 USC § 103*

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 17 - 19, 21- 25, 27 - 31 and 33 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Kalra et al. (U.S. Pat. No. 5,953,506) (Method and Apparatus that Provides a

Scalable media Delivery System)

5.1   Regarding claims 17 - 19, 21- 25, 27 - 31 and 33, the previous rejection under 35

USC 103 (paper #3; 10/4/2000) applies fully.

6.   Claims 20, 26, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kalra as applied to claim 17, 23 and 29 above, and further in view of Parsons, Jr. et al. (U.S. Pat.

No. 6,085,247) (Server Operating System for Supporting Multiple Client-Server Sessions and Dynamic Reconnection of Users to Previous Sessions Using Different Computers).

6.1   Per claim 20, 26, and 32, the previous rejection under 35 USC 103 (paper #3; 10/4/2000) applies fully.

7.   Claims 17 - 19, 21- 25, 27 - 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt et al. (U.S. Pat. No. 5,764,235) (Computer Implemented Method and System for Transmitting Graphical Images from Server to Client at User Selectable Resolution).

7.1   Regarding claim 17, Hunt discloses a computing system comprising:

a client (Figs. 1A and 1B, item 104; Fig. 2, item 204; Abstract); and

a server having server control routines and connected to the client by a data link (Figs. 1A and 1B, items 102, 104, 106, 108; Fig. 2, items 202, 204, 206; Abstract);

wherein the server control routines, upon a request to download by a client, determine one or both of hardware or software characteristics of the client, transpose data, without further negotiation with the client, and transmit the transposed data to the client in a form specifically adapted to the characteristics of the client, and wherein, in the transposing, a first set of streams is transposed into a second set of streams fewer in number than the first set of streams (Abstract; col. 2, lines 15 - 30).

However, Hunt does not explicitly disclose a "*set of files*" but rather **information** (Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to implement a "set of files" in Hunt because Hunt discloses an art recognized equivalent

information.

7.2   Per claim 18, Hunt teaches that the second set of streams comprises a single file (col. 1,

lines 48 - 52).

7.3   Regarding claim 19, Hunt discloses that the number of files in the second set of files is a

function of the characteristics of the client (Abstract).

7.4   Per claim 21, Hunt discloses that the server transposes HTML files (col. 5, lines 44 - 46).

7.5   Regarding claim 22, Hunt discloses that the client transfers to the server information

particular to the hardware or software characteristics of the client, and wherein the server

incorporates the information in transposing data for transfer to the client (Abstract; col. 2, lines

15 - 30).

However, Hunt does not explicitly disclose that the client transfers this information **upon log-in**

at the server.

It would have been obvious to one of ordinary skill in the art at the time of the invention to

implement the transfer of client characteristics to the server **upon log-in at the server** because

such at log-in is the logical time to implement the transfer of client characteristics because the

client characteristics are necessary to customize the information download from server to client;

and customized downloading can not occur until these client characteristics are known to the

server.

7.6   Per claims 23 - 25, 27 - 31 and 33, the rejection of claims 17 - 19, 21, and 22 applies

fully.

Response to Arguments

8.   The Terminal Disclaimer discussed in Amendment B (filed 1/02/2001) is not present in

the Application.

9.   Applicant's arguments filed 1/02/2001 have been fully considered but they are not

persuasive.

Applicant states that "Applicant believes and asserts that the claims in the present application are

fully supported in the disclosure filed 4/10/96."

Examiner disagrees.

The transposition of data, "without further negotiation with the client" is apparently not disclosed

in Kikinis (U.S. Pat. No. 6,076,109).

In addition, the saving of copy of the transposed data for future communication with the same

client is not seen in <u>Kikinis</u> (U.S. Pat. No. 6,076,109).

Conclusion

10.   Applicant is requested to submit a clean copy of pages 21, 22, and 23 of the specification,

due to the extraneous marks on the original copies submitted to the Patent Office.

11.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

<u>Smith et al.</u>   U.S. Pat. No. 6,128,649   Dynamic Selection of Media Streams for
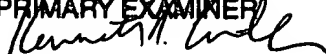
Display

<u>Koistinen et al.</u>   U.S. Pat. No. 6,154,778   Utility-Based Multi-Category

Quality-of-Service Negotiation in Distributed Systems

<u>R. Wang et al.</u>   A Multimedia File Structure for Continuous and Discrete Media;

Canadian Conf. On Electrical and Computer Engineering, 1993; pp. 644-647; 9/1993

12.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kenneth Coulter whose telephone number is (703) 305-8447.

KENNETH R. COULTER
PRIMARY EXAMINER

krc

March 26, 2001